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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,706	04/16/2002	Camilo Anthony Leo Selwyn Colaco	8830-23	7593

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EXAMINER

NAVARRO, ALBERT MARK

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/049,706	<b>Applicant(s)</b> COLACO, CAMILO ANTHONY LEO SELWYN	
	<b>Examiner</b> Mark Navarro	<b>Art Unit</b> 1645	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 11, 2005 has been entered.

Claims 18-19 have been cancelled, and new claim 23 has been added. Consequently, claims 1-17 and 20-23 are pending in the instant application, of which claims 1-13 and 20-22 have been withdrawn from further consideration as being drawn to a non-elected invention.

This application contains claims 1-13 and 20-22 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. The rejection of claims 14-17 under 35 U.S.C. 102(b) as being anticipated by Tunnacliff et al is maintained. Additionally, this rejection is applied to newly added claim 23.

Applicants are asserting that Tunnacliffe does not identify the fact that cells in which trehalose has been induced are more immunogenic than cells in which intracellular trehalose is produced. Applicants further assert that the claims have been amended to recite that the cells can be used to induce immunity **without** the cell having been subjected to the process of drying. Applicants further assert that there would be no motivation to skip the drying step, as there is no suggestion that such cells would be more immunogenic over cells which did not have the level of intracellular trehalose increased therein.

Applicants arguments have been fully considered but are not found to be fully persuasive.

First, Applicants are asserting that the cited prior art does not disclose or suggest that cells that have been induced to increase trehalose production may be more immunogenic than non-induced cells. However, "the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the

Art Unit: 1645

discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Second, Applicants further assert that the claims have been amended to recite that the cells can be used to induce immunity ***without*** the cell having been subjected to the process of drying. However, Tunnacliffe disclose a composition which has not been subjected to the process of drying. Applicants attention is respectfully directed to Example 7, in which prokaryotic cells, following intracellular induction of trehalose, were suspended in sugar and carboxymethyl cellulose. (See column 18). This suspension was aliquotted into pharmaceutical vials. The composition contained within these pharmaceutical vials meet each and every limitation of the claimed invention. While the composition was later dried, it does not detract from the fact that in the pharmaceutical vial, prior to drying, the composition was identical to that instantly claimed.

Finally, Applicants assert that there would be no motivation to skip the drying step, as there is no suggestion that such cells would be more immunogenic over cells which did not have the level of intracellular trehalose increased therein. However, as set forth above, Tunnacliffe discloses the identical composition as claimed in a pharmaceutical vial, prior to being dried. Accordingly, each and every limitation has been disclosed by the teachings of Tunnacliffe.

Art Unit: 1645

Tunnacliff et al (WO 98/24882) disclose of a vaccine composition comprising a prokaryotic cell, which contains at least 10 mM of trehalose within the cell. (See pages 6, 13, 21 and claims).

For reasons of record, as well as the reasons set forth above, this rejection is maintained.

2. The rejection of claims 14-17 under 35 U.S.C. 102(e) as being anticipated by Tunnacliff et al (US Patent 6,468,782) is maintained. Additionally, this rejection is applied to newly added claim 23.

Applicants assertions are identical to those recited above in paragraph number 1, and have been fully addressed in paragraph number 1.

Accordingly, this rejection is maintained for reasons of record, as well as the reasons set forth above in paragraph number 1.

The following new grounds of rejection are applied to the claims:

***Claim Rejections - 35 USC § 112***

3. Claims 14-17 and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written

Art Unit: 1645

description rejection.

Claims 14-17 and 23 recite an immunogenic determinant or cell residue of a prokaryotic cell.

The specification and claims do not indicate what distinguishing attributes are shared by the members of the genus. Thus, the scope of the claims includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between genus members is permitted. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, and because the genus is highly variant, an "immunogenic determinant or cell residue" alone are insufficient to describe the genus. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, applicant was not in possession of the claimed genus.

Adequate written description requires more than a mere statement that it is part of the invention and a reference to a potential method of isolating it. The protein itself is required. See *Fiers v. Revel*, 25 USPQ 2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

*Vas-Cath Inc. V. Mahurkar*, 19 USPQ2d 111, clearly states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed."

Art Unit: 1645

Applicant is reminded that Vas-Cath make clear that the written description provision of 35 USC 112 is severable from its enablement provision.

Furthermore, in *The Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus by only their functional activity does not provide an adequate written description of the genus. The court indicated that while Applicants are not required to disclose every species encompassed by a genus, the description of a genus is achieved by the recitation of a **representative number** of DNA molecules, usually defined by a nucleotide sequence, falling within the scope of the claimed genus. At section B(1), the court states that "An adequate written description of a DNA... requires a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention." (Emphasis added).

Applicants are directed to the Revised Interim Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, 1 "Written Description" Requirement, Federal Register, Vol. 64, No. 244, pages 71427-71440, Tuesday December 21, 1999.



Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro whose telephone number is (571) 272-0861.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Navarro  
Primary Examiner  
November 3, 2005